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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,640	02/25/2002	Norikazu Iwase	219581USOPCT	1924

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/21/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,640

Applicant(s)

IWASE ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

**Claims 1-6 are included in the prosecution of this application.**

### ***Information Disclosure Statement***

The references cited in the Search Report have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

### ***Claim Objections***

Claims 4-5 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 4-5 not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 3 recites four ceramide formulas; it is unclear whether the composition contains all four ceramide formulas or one of the four. Further clarification is requested.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Jacquet et al (4,608,392).**

Jacquet et al disclose massage oil containing 15 grams triglycerides, 3 grams vegetable oil, and 2 grams lavender oil, among other components. See example 31.

\*Lavender oil inherently contains instant terpenes: limonene,  $\alpha$ - pinene, and  $\beta$ -pinene in the instant amount, note cited art of interest.

**Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by GB 1,567,496.**

GB discloses a topical composition containing esters of terpene alcohols with a carboxylic acid in the amount of 0.1-20%. The terpene alcohol is borneol. See page 2, lines 45 and tables. The composition contains terpene ester with triglycerides in the amount of 9%. See page 6.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candau et al (5,776,480) in view of Grieveson et al (5,912,002).**

Candau et al disclose a ceramide cosmetic/dermatological composition for dry skin. See column 3 for the compound formula. The composition may contain a combination of ceramide III, V, and II and utilized up to 65%. See column 19-25. The composition contains lipophilic adjuvants such as essential oils, fatty acids, fatty alcohols, waxes, etc. in the amount of 0.1-20%. See column 4, lines 55-65.

Candau et al do not specify the essential oil.

Grieveson et al disclose a cosmetic composition contains a benefit agent. The benefit agent is an agent that moisturizes, conditions, and protects the skin. See column 2, lines 54-60. Essential oils such as white cedar, orange, eucalyptus, lavender, limonene, and other terpenoid oil are taught as one type of benefit agent. Other benefit agents taught to moisturize the skin are cholesterol and ceramides. The reference teaches a mixture of the benefit agents. See column 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Candau et al and Grieveson et al and

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utilize instant essential oils. One would be motivated to do so since Grieveson discloses that these essential oils are utilized to protect and condition the skin. Further, one would expect similar results since Candau et al teach the use of essential oils in a moisturizing composition. Therefore, a skilled artisan would be motivated to add essential oils in the composition to increase the ability of the composition to moisturize and condition the skin and yield an additive effect. It is obvious to combine two components each of which is taught by the prior art to for the same purpose of conditioning and moisturizing the skin, in order to form a third composition for the same purpose of moisturizing and conditioning the skin.

**Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/14401 by itself or in view of Hattori et al (6,194,468).**

WO teaches a cosmetic composition for improving skin roughness and wrinkles. See page 1. The composition contains ceramide derivatives in the amount of 0.001-50% and 0.0001-20% vegetable extracts such as sage, eucalyptus, lemon, and orange peel, among other components. The extracts are obtained by grinding the whole plant or parts such as leaves, barks, roots, seeds, fruits, and nuts. See page 22. Other components such as sterols are taught. See page 27. The composition may contain oily substances such as ester oils (peppermint and eucalyptus oil) in the amount of 0.005-30%. See page 43. Terpene alcohols such as farnesol are taught for formulations that condition the hair. See page 53.

WO does not exemplify the instant vegetable extracts or specify all the instant terpenes.

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Hattori et al teach farnesol, santalol, and vetivenol are sesquiterpene alcohols and essential oils such peppermint oil, cedar oil, etc. that contain terpenes. See column 2-3.

It would have been obvious to one of ordinary skill in the art at the time the invention was look to WO 97/14401 and utilize any of the extracts of choice. One would be motivated to do so since Hattori teaches the suitability of all the extracts listed on page 27. Note that the vegetable extracts taught such as orange peel, lemon, etc. inherently contain terpenes since WO teaches using the entire plant to obtain the extract. Further, one would be motivated to use a terpene alcohol to formulate a conditioning hair composition. Therefore, it is deemed obvious to look at the guidance of WO and arrive at instant composition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of WO and Hattori et al and utilize the instant terpene. One would be motivated to do so since Hattori teaches that farnesol, santalol, and vetivenol are sesquiterpene alcohols. Furthermore, Hattori teaches that essential oils such as peppermint oil contain terpenes. Therefore, a skilled artisan could expect similar results by substituting farnesol with the instant terpenes and expect similar results since Hattori et al teaches their functional equivalency.

#### ***Art of Interest***

US patent 6,190,685 is cited as art of interest to demonstrate inherency that essential oils contain instant terpenes.

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***Correspondenc***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SSG

10/13/03

  
THURMAN K. PAGE  
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